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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,969

06/30/2006

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BACN0101PUSA

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EXAMINER

CHEEMA, AZAM M

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,969	<b>Applicant(s)</b> BACON, CHARLES F.	
	<b>Examiner</b> AZAM CHEEMA	<b>Art Unit</b> 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Application No. 10/596,969 filed on 06/30/2006 has been examined. In this Office Action, claims 1-44 are pending.

### **Oath/Declaration**

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

### **Priority**

3. As required by **M.P.E.P. 201.14(c)**, acknowledgement is made of applicant's claim for priority based on the application filed on Dec 30, 2003 (60/533,143).

### **Drawings**

4. The applicant's drawings submitted are acceptable for examination purposes.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claims 1 and 24 Method steps do not associated with particular machine (general computer); therefore, it is rejected under 35 U.S.C. 101.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Federal Circuit in *In re Bilski*, must (1) be tied to another statutory class (such as a particular apparatus) or (transform underlying subject matter (such as an article or materials) to a different state or thing.

Claims 2-12 are also rejected under 35 U.S. C 101 because they fail to resolve the deficiencies of claim 1.

Claims 25-34 are also rejected under 35 U.S. C 101 because they fail to resolve the deficiencies of claim 24.

Claims 13 and 35 recites the use of various components and elements that would be reasonably understood by one of ordinary skill in the art to mean software, a software based component implementation, or an abstract concept based on software. Examples of components and concepts used in the claim are: generating at least one module, adding user information, comparing the user information, generating a report and other such terms that are interpreted to mean abstract concepts and software implementations. There are no definitive hardware or physical components associated with these examples in the claims or in the specification.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter.

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As such, they fail to fall within a statutory category. They are, at best functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Claims 14-23 are also rejected under 35 U.S. C 101 because they fail to resolve the deficiencies of claim 13.

Claims 36-44 are also rejected under 35 U.S. C 101 because they fail to resolve the deficiencies of claim 35.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheppard et al (US PAT. NO: 5,820,386) in view of Boe et al (US PAT.NO: 6,236,975 B1).

As per claim 1, Sheppard teaches a method for evaluating information, comprising the steps of: generating at least one module containing selected information in a chosen subject area, the at least one module including at least one metric from at least one source in the subject area (col.7, lines 22-26, Database includes all that is needed to accurately test user knowledge of topics with question/fact sets. For dictionary-type topics there is optionally one or more multiple-choice selection sets for each topic. For encyclopedia-type topics there are optionally multiple facts about each topic available for use as clues from which the user is asked to identify the topic); prompting a user of the at least one module for user information relating to the chosen subject area (Fig.4, Ask user for age level and desired topic area); adding the user information to the module (Fig.4, narrow topic list to those meeting above criteria); comparing the user information with the at least one metric to produce at least one score (col.7, lines 53-55, if the

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answer is correct points are added to the user score and the user is asked whether or not to continue, if the user wishes to stop a final score is displayed);

But does not explicitly teach generating a report derived from the at least one score.

However, Boe teaches generating a report derived from the at least one score (Fig.6b, col.19, lines 10-20, report for a business representative generated by business report generator, the report may also include a product/service identifier, columns in the report may include customer identification number, probability of purchase and link to probability).

It would have been obvious to one of the ordinary skill in the art at the time invention was made to combine Boe's teaching with Sheppard's teaching allows the business to target its marketing efforts for specific products and services to specific customers who are more likely than the general population to purchase those products and services (col.1, lines 58-63, Boe).

As per claim 2, further comprising the steps of changing the user information in the module to produce new user information, and comparing the new user information with the at least one metric to produce at least one second score (Fig.6b, Boe).

As per claim 3, wherein said steps of changing the new user information and comparing new user information are repeated until a desired at least one second score is obtained (Fig.6b, Boe).

As per claim 4, wherein the chosen subject area comprises business, and wherein the selected information comprises financial data and non-financial data, the non-financial data

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comprising at least one of: information relating to businesses similar to that of the user, previous user response information, business rules, business boundary conditions, organization chart data, supply chain data, market data, regulatory data, environmental data, communication link data, human resources data, data relating to operations, data relating to products and services, data relating to technologies used in providing such products and services, and data relating to business success or business failure (col.1, lines 58-63, Boe).

As per claim 5, wherein said at least one module is part of a database (col.7, lines 35-40, Sheppard).

As per claim 6, wherein said step of comparing is performed using a computer.

As per claim 7, wherein the algorithms are selected from the group consisting of benchmarking, pattern recognition analysis, complexity analysis, automatic adaptation, prioritization concept recognition, conceptual relationship analysis, arithmetic logic, symbolic rule induction, self-organizing data and information mapping, neural network analysis, decision tree classification, lexicon development, and scoring key creation, are used by the computer in said step of comparing.

As per claim 8, wherein the computer is selected from the group consisting of stand alone computers, linked computers, and a computer network (Fig.1, Boe).



As per claim 9, wherein the computer network comprises a local area network (col.3, lines 62-67, Boe).

As per claim 10, wherein the computer network comprises a wide area network (col.3, lines 62-67, Boe).

As per claim 11, wherein the computer network comprises the internet (col.3, lines 62-67, Boe).

As per claim 12, further comprising the step of using the report to generate a decision-making assessment (ol.18, lines 54-29, Boe).

As per claim 13, Sheppard teaches an apparatus for evaluating information, comprising in combination: means for generating at least one module containing selected information in a chosen subject area, said at least one module including at least one metric from at least one source in the subject area (col.7, lines 22-26, Database includes all that is needed to accurately test user knowledge of topics with question/fact sets. For dictionary-type topics there is optionally one or more multiple-choice selection sets for each topic. For encyclopedia-type topics there are optionally multiple facts about each topic available for use as clues from which the user is asked to identify the topic); means for adding user information relating to the chosen subject area to said at least one module (Fig.4, narrow topic list to those meeting above criteria); means for comparing the user information with the at least one metric to produce at least one

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score (col.7, lines 53-55, if the answer is correct points are added to the user score and the user is asked whether or not to continue, if the user wishes to stop a final score is displayed);

But does not explicitly teach means for generating a report derived from the at least one score.

However, Boe teaches means for generating a report derived from the at least one score (Fig.6b, col.19, lines 10-20, report for a business representative generated by business report generator, the report may also include a product/service identifier, columns in the report may include customer identification number, probability of purchase and link to probability).

It would have been obvious to one of the ordinary skill in the art at the time invention was made to combine Boe's teaching with Sheppard's teaching allows the business to target its marketing efforts for specific products and services to specific customers who are more likely than the general population to purchase those products and services (col.1, lines 58-63, Boe).

As per claim 14, further comprising means for changing the user information in said module to produce new user information, and means for comparing the new user information with the at least one metric to produce at least one second score Fig.6b, Boe).

As per claim 15, wherein the chosen subject area comprises business, and wherein the selected information comprises financial data and non-financial data, the non-financial data comprising at least one of: information relating to businesses similar to that of the user, previous user response information, business rules, business boundary conditions, organization chart data, supply chain data, market data, regulatory data, environmental data, communication link data, human resources data, data relating to operations, data relating to products and services, data

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relating to technologies used in providing such products and services, and data relating to business success or business failure (col.1, lines 58-63, Boe).

As per claim 16, wherein said at least one module is part of a database col.7, lines 35-40, Sheppard).

As per claim 17, wherein said means for comparing comprises a computer (Fig.1, Boe).

As per claim 18, wherein said computer uses algorithms selected from the group consisting of benchmarking, pattern recognition analysis, complexity analysis, automatic adaptation, prioritization concept recognition, conceptual relationship analysis, arithmetic logic, symbolic rule induction, self-organizing data and information mapping, neural network analysis, decision tree classification, lexicon development, and scoring key creation (col.7, lines 20-40, Sheppard).

As per claim 19, wherein said computer is selected from the group consisting of stand alone computers, a plurality of linked computers, and a computer network (Fig.1, Boe).

As per claim 20, wherein said computer network comprises a local area network (col.3, lines 62-67, Boe).

As per claim 21, wherein said computer network comprises a wide area network (col.3,

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lines 62-67, Boe).

As per claim 22, wherein said computer network comprises the internet (col.3, lines 62-67, Boe).

As per claim 23, wherein the generated report is used to generate a decision-making assessment (col.18, lines 54-29, Boe).

As per claim 24, Sheppard teaches a method for evaluating business information, comprising the steps of:

prompting a user of the at least one module for user information relating to the chosen subject area (Fig.4, Ask user for age level and desired topic area);

adding the user information to the module (Fig.4, narrow topic list to those meeting above criteria);

comparing the user information with the at least one metric to produce at least one score (col.7, lines 53-55, if the answer is correct points are added to the user score and the user is asked whether or not to continue, if the user wishes to stop a final score is displayed);

but does not explicitly teach generating at least one module comprising financial data and non-financial data, the non-financial data comprising at least one of: information relating to businesses similar to that of the user, previous user response information, business rules, business boundary conditions, organization chart data, supply chain data, market data, regulatory data, environmental data, communication link data, human resources data, data relating to

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operations, data relating to products and services, data relating to technologies used in providing such products and services, and data relating to business success or business failure, the at least one module including at least one metric from at least one source in the subject area; and generating a report derived from the at least one score.

However, Boe teaches generating at least one module comprising financial data and non-financial data, the non-financial data comprising at least one of: information relating to businesses similar to that of the user, previous user response information, business rules, business boundary conditions, organization chart data, supply chain data, market data, regulatory data, environmental data, communication link data, human resources data, data relating to operations, data relating to products and services, data relating to technologies used in providing such products and services, and data relating to business success or business failure, the at least one module including at least one metric from at least one source in the subject area (col.1, lines 58-63, a business may obtain information from customers that allows the business to target its marketing efforts for specific products and services to specific customers who are more likely than the general population to purchase those products and services); and generating a report derived from the at least one score (Fig.6b, col.19, lines 10-20, report for a business representative generated by business report generator, the report may also include a product/service identifier, columns in the report may include customer identification number, probability of purchase and link to probability).

It would have been obvious to one of the ordinary skill in the art at the time invention was made to combine Boe's teaching with Sheppard's teaching allows the business to target its marketing

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efforts for specific products and services to specific customers who are more likely than the general population to purchase those products and services (col.1, lines 58-63, Boe).

As per claim 25, further comprising the steps of changing the user information in the module to produce new user information, and comparing the new user information with the at least one metric to produce at least one second score (Fig.6b, Boe).

As per claim 26, wherein said steps of changing the new user information and comparing new user information are repeated until a desired at least one second score is obtained (Fig.6b, Boe).

As per claim 27, wherein said at least one module is part of a database (col.7, lines 35-40, Sheppard).

As per claim 28, wherein said step of comparing is performed using a computer (Fig.1, Boe).

As per claim 29, wherein the algorithms are selected from the group consisting of benchmarking, pattern recognition analysis, complexity analysis, automatic adaptation, prioritization concept recognition, conceptual relationship analysis, arithmetic logic, symbolic rule induction, self-organizing data and information mapping, neural network analysis, decision tree classification, lexicon development, and scoring key creation, are used by the computer in

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said step of comparing (col.7, lines 20-40, Sheppard).

As per claim 30, wherein the computer is selected from the group consisting of stand alone computers, linked computers, and a computer network (Fig.1, Boe).

As per claim 31, wherein the computer network comprises a local area network (col.3, lines 62-67, Boe).

As per claim 32, wherein the computer network comprises a wide area network (col.3, lines 62-67, Boe).

As per claim 33, wherein the computer network comprises the internet (col.3, lines 62-67, Boe).

As per claim 34, further comprising the step of using the report to generate a decision-making assessment (col.18, lines 54-29, Boe).

As per claim 35, Sheppard teaches an apparatus for evaluating business information, comprising in combination: means for adding user information relating to the chosen subject area to said at least one module, wherein the user information comprises financial data plus other information (Fig.4, Ask user for age level and desired topic area); means for comparing the user information with the at least one metric to produce at least one score (col.7, lines 53-55, if the

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answer is correct points are added to the user score and the user is asked whether or not to continue, if the user wishes to stop a final score is displayed);

But does not explicitly teach means for generating at least one module comprising financial data and non-financial data, the non-financial data comprising at least one of: information relating to businesses similar to that of the user, previous user response information, business rules, business boundary conditions, organization chart data, supply chain data, market data, regulatory data, environmental data, communication link data, human resources data, data relating to operations, data relating to products and services, data relating to technologies used in providing such products and services, and data relating to business success or business failure, the at least one module including at least one metric from at least one source in the subject area, said at least one module including at least one metric from at least one source in the subject area; and means for generating a report derived from the at least one score.

However, Boe teaches means for generating at least one module comprising financial data and non-financial data, the non-financial data comprising at least one of: information relating to businesses similar to that of the user, previous user response information, business rules, business boundary conditions, organization chart data, supply chain data, market data, regulatory data, environmental data, communication link data, human resources data, data relating to operations, data relating to products and services, data relating to technologies used in providing such products and services, and data relating to business success or business failure, the at least one module including at least one metric from at least one source in the subject area, said at least one module including at least one metric from at least one source in the subject area(col.1, lines 58-63, a business may obtain information from customers that allows the business to target its



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marketing efforts for specific products and services to specific customers who are more likely than the general population to purchase those products and services); and means for generating a report derived from the at least one score (Fig.6b, col.19, lines 10-20, report for a business representative generated by business report generator, the report may also include a product/service identifier, columns in the report may include customer identification number, probability of purchase and link to probability).

It would have been obvious to one of the ordinary skill in the art at the time invention was made to combine Boe's teaching with Sheppard's teaching allows the business to target its marketing efforts for specific products and services to specific customers who are more likely than the general population to purchase those products and services (col.1, lines 58-63, Boe).

As per claim 36, further comprising means for changing the user information in said module to produce new user information, and means for comparing the new user information with the at least one metric to produce at least one second score (Fig.6b, Boe).

As per claim 37, wherein said at least one module is part of a database (col.7, lines 35-40, Sheppard).

As per claim 38, wherein said means for comparing comprises a computer (Fig.1, Boe).

As per claim 39, wherein said computer uses algorithms selected from the group consisting of benchmarking, pattern recognition analysis, complexity analysis, automatic

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adaptation, prioritization concept recognition, conceptual relationship analysis, arithmetic logic, symbolic rule induction, self-organizing data and information mapping, neural network analysis, decision tree classification, lexicon development, and scoring key creation (col.7, lines 20-40, Sheppard).

As per claim 40, wherein said computer is selected from the group consisting of stand alone computers, a plurality of linked computers, and a computer network (Fig.1, Boe).

As per claim 41, wherein said computer network comprises a local area network (col.3, lines 62-67, Boe).

As per claim 42, wherein said computer network comprises a wide area network (col.3, lines 62-67, Boe).

As per claim 43, wherein said computer network comprises the internet (col.3, lines 62-67, Boe).

As per claim 44, wherein the generated report is used to generate a decision-making assessment (col.18, lines 54-29, Boe).



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Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the similar limitations to produce the same end result of providing a communication device with multiple functionalities.

It would have been obvious to a person with ordinary skills in the art at the time of the invention was made to modify or to omit the additional elements of ODP claim(s) of copending applications listed above to arrive at **claim** 1, 13, 24 and 35 of the instant application because the person would have realized that the remaining element would perform the same functions as before. “Omission of element ad its function in combination is obvious expedient if the remaining elements perform same functions as before.” See *In re Karlson* (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

This is a provisional obvious double patenting rejection since the conflicting claims have not yet been patented.

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azam Cheema whose telephone number is 571-270-1753. The examiner can normally be reached on Monday-Friday 7.30a.m-5.00p.m ALT Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam Hosain can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A.C/

Examiner, Art Unit 2166

May 8, 2009

/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166